

PATENT APPLN. NO. 10/762,530
RESPONSE UNDER 37 C.F.R. § 1.116

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REMARKS

Claims 1 and 3 are identified in the Final Action as being rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhard et al., U.S. Patent No. 6,331,174 ("Reinhard"). However, based upon the explanation of the rejection in the Action, it is clear that the Office is also relying on Kaufhold, Jr. et al., U.S. Patent No. 5,125,898 ("Kaufhold"), that was cited in the prior Action.

Reconsideration of the 35 U.S.C. § 103(a) rejection of claims 1 and 3 over Reinhard in view of Kaufhold is requested. The proposed modification of the syringe of Reinhard will not result in the prefilled syringe defined by claims 1 and 3 of the present application. Furthermore, the proposed modification is not proper under 35 U.S.C. § 103(a).

First, claims 1 and 3 of the application recite that the syringe of the present invention comprises a barrel having a multilayer structure in which an innermost layer and an outermost layer are both made of a polyolefin resin. The Office, referring to the description in Col. 4, line 11, of Reinhard, alleges that the innermost layer and outermost layer of the syringe of Reinhard are both made of polyolefin resin. Col. 4, line 11, of Reinhard describes a cyclic olefin polymer (COC).

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A cyclic olefin polymer is not a polyolefin. A polyolefin is a family of thermoplastics derived from the ethylene family of simple olefins, i.e., ethylene, propylene, butene. (Refer to the enclosed printouts of definitions of the term "polyolefin" from "www.chemicals-technology.com" and "www.yourdictionary.com").

Although the Office can give claim terms their broadest reasonable interpretation consistent with the specification, the terms of a claim cannot be interpreted in a manner that is inconsistent with the accepted meaning of the term in the prior art.

Therefore, Reinhard cannot be properly interpreted as disclosing a syringe in which the innermost layer and outermost layer are both made of a polyolefin. Thus, the proposed modification of the syringe of Reinhard will not result in a prefilled syringe that is within the scope of claims 1 and 3 of the present application.

Second, claims 1 and 3 of the present application recite that the prefilled syringe of the present invention comprises a shoulder portion provided with a luer tip arranged to be connected to an injection needle at a tip thereof. The Office, admitting that the syringe of Reinhard does not include a luer tip, asserts that it would have been obvious to modify the syringe of Reinhard such that

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it comprises a luer tip, as taught by Kaufhold. This proposed modification of the syringe of Reinhard is improper.

The invention of Reinhard is a prefilled, disposable syringe that overcomes the problems of disposable syringes of the prior art. One of these prior art disposable syringes is that disclosed in U.S. Patent No. 4,861,335 that includes a luer tip. (Note the description of the prior art syringe in Col. 2, lines 17-19, of Reinhard: "The hypodermic needle is fastened to the cap by means of a mounting method known under the brand name LUER-LOCK."). The object of the invention of Reinhard is to provide a prefilled syringe that can be manufactured as a preassembled unit "consisting of a barrel with an integrated needle ...". (Col. 2, lines 42-43).

It has been established by the Office that references cannot be properly combined if the effect would destroy the invention on which one of the references is based. (See *Ex parte Hartmann*, 186 USPQ 366 (BdPatApp&Int 1974)).

For these reasons, the combination of Reinhard and Kaufhold cannot properly support a case of prima facie obviousness under 35 U.S.C. § 103(a) of claims 1 and 3 of the present application. Removal of the rejection and a notice of allowability of claims 1 and 3 are in order and are respectfully requested.

The foregoing is believed to be a complete and proper response

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to the Office Action dated May 28, 2009.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,
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Attachments: Printouts from www.chemicals-technology.com and
www.yourdictionary.com

Term: Polyolefin

Definition:

A polyolefin is a family of thermoplastics derived from the ethylene family of simple olefins. polyethylene and polyisoprene are important polyolefins which can be used to make fibers.

OCT 28 2009

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polyolefin

polyolefin definition

poly-olefin (pāl'ē ō'la fin)

noun

any of a group of thermoplastic polymers, as polyethylene or polypropylene, made from any simple alkene

Etymology: *poly-* + *olefin*

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